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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,902	10/30/2003	Alberto Rodriguez	A3026-US-NP XERZ 2 02200	9247
62095 7590 02/11/2011 FAY SHARPE / XEROX - ROCHESTER 1228 EUCLID AVENUE, 5TH FLOOR THE HALLE BUILDING CLEVELAND, OH 44115			EXAMINER DHINGRA, PAWANDEEP	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 02/11/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/696,902	Applicant(s) RODRIGUEZ ET AL.	
	Examiner PAWANDEEP S. DHINGRA	Art Unit 2625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-10,13-17,20-25.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/David K Moore/
 Supervisory Patent Examiner, Art Unit 2625

/P. D./
 Examiner, Art Unit 2625

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that references fail to teach a replaceable module comprising: an internal memory with a non-volatile core portion and a volatile portion for holding instructions.

In reply, examiner asserts that Richards discloses a replaceable module (removable module, see abstract) for a printing apparatus (printer 10, fig. 1) with programmable software controls (see figure 2 with text; abstract, note chip is programmable), the module comprising: an internal memory comprising a non-volatile core portion (CRUM memory 34, fig. 2) for holding stored instructions (see abstract; column 4, lines 4-64).

Turnbull teaches a module (controller 302, fig. 3) for printing apparatus (device 102 is a printer, fig. 3 with text) with programmable software controls (EEPROM is programmable), the module comprising: an internal memory comprising a non-volatile core portion (hard disk 310) and a volatile portion (volatile memory 306) for holding stored instructions (see fig. 3 with text).

It would have been obvious to one with ordinary skill in art to modify the replacement module and its system as disclosed by Richards to have both the non-volatile and volatile memory to be included into a module as taught by Turnbull for the benefit of having both primary storage options which can access data randomly and faster versus secondary long term storage options where data can be retained for long periods without needing power in one module unit in order to facilitate in automatically installing firmware upgrades when available as taught by Turnbull at col. 1, lines 8-12 and fig. 3

Applicant further argues that references fail to teach a peripheral memory external to module, comprising increased storage space for holding a software upgrade for the printing apparatus.

In reply, examiner asserts that Hirst teaches a module comprising: a peripheral memory (consumable memory device 19, fig. 1) external to said module, comprising increased storage space for (note that memory device 19 is affixed to the replaceable toner module 18. It doesn't need to be within the housing of the toner 18, thus memory 19 is situated external to the housing of toner 18 comprising extra space for storing upgrades, see col. 4, lines 45-49) holding a software upgrade for the printing apparatus programmable software controls (see column 4, line 45-column 5, line 65) (see also column 2, line 55-column 3, line 33).

Turnbull also teaches a peripheral memory (memory of server 110, fig. 3) external to module, comprising increased storage space for holding a software upgrade for the printing apparatus (note that memory present in server 110 holds the available firmware upgrade for the printing device 102 (see col. 4, line 49-col. 5, line 52).

Applicant further argues that Turnbull fails to teach that the upgrades can be installed automatically.

In reply, examiner again asserts that claims do not recite that upgrades are installed completely automatically without any action on part of the user as seemed to be argued by the applicant.

Turnbull does teach that upgrades are automatically downloaded and installed by the microprocessor as required by the claims regardless of the fact that upgrades are installed after user selection of an option (see col. 5, lines 36-42; col. 7, lines 25-34). Upgrades are always automatically installed by the microprocessor as claimed. Claims do not limit or specifically define a completely automatic installation which cannot include any user involvement. These features shall be recited in claims to be given any patentable weight.

Applicant further argues that Hara is directed to an nonanalogous art and one would look into Hara when presented with claimed invention.

In reply, examiner asserts it has been held that a prior art reference is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, claimed invention requires monitoring progress of installing upgrades and reporting any error that occur during the process, thus one would look into references which deal with downloading and installing software packages or upgrades. Do note that downloading and installing software packages or upgrades into apparatuses and monitoring the progress is very well known in the art. Hara teaches downloading and installing software onto apparatuses and reporting the progress and faults of the updating process to the user. Thus, one skill in the art would have totally been inclined to look into the areas of art such as Hara, which deal with monitoring & reporting pertaining to downloading and installing of software, analogous to the limitations as claimed.

Applicant further argues that there is no teaching, suggestion, or motivation to combine the references.

In reply, examiner asserts that it would have been totally obvious to one skilled in the art to look for those common features in the cited arts and to modify the replacement module system as disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst, upgrading techniques of Turnbull and monitoring and error reporting techniques for upgrading packages as taught by Hara to come up with claimed invention for the benefits as stated previously.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

